UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of CREE et al.   :
Application No.: 10/582,313   : DECISION ON PETITION
PCT No.: PCT/US04/41434   :
Int. Filing: 08 December 2004   : UNDER 37 CFR 1.47(a)
Priority Date: 08 December 2003   :
Attorney Docket No.: 345US   :
For: DIFFERENTIAL ENERGY COMPOSITES :
AND METHODS OF MANUFACTURING   :

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 16 May 2007, to accept the application without the signature of joint inventor, Toni Rae Millikan. Applicant requests a one month extension of time, which is granted.

BACKGROUND

On 08 June 2006, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 16 February 2007, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 16 May 2007, applicant filed the instant petition along with a declaration, executed by the joint inventor on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor, Toni Rae Millikan alleging that Ms. Millikan refuses to sign the application.

On 05 June 2007, a Notification of Acceptance was mailed inadvertently to applicant indicating that applicant had satisfied the requirements of 35 U.S.C. 371.

DISCUSSION

A review of the USPTO records reveals that applicant has not yet satisfied the requirements of 35 U.S.C. 371 and thus, the 5 June 2007 Notification of Acceptance was erroneously issued and is hereby **VACATED.**

Petition under 37 CFR 1.47(a)

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known address of non-signing inventor, Toni Rae Millikan was provided. Petitioner submitted a declaration executed by the joint inventor, James W. Cree, satisfying Item (4) above.

With respect to Item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

> *A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor*, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the *inventor be presented with* the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)

> Where a refusal of the inventor to sign the application papers is alleged, *the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers* and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

(Emphasis added.)

Petitioner provided Dean Y. Shahriari's statement in support of the petition under 37 CFR 1.47(a). At the outset, it is noted that Mr. Shahriari's statement is not one of first hand knowledge. Such statement is required. Mr. Shahriari states that on 05 April 2007, a copy of *the declaration and power of attorney* was sent to Ms. Millikan for her signature. A copy of this letter was attached to the statement. It is clear that Petitioner did not present a complete copy of the application papers (including specification, claims and any drawings along with the declaration) for Ms. Millikan's signature. A complete copy of the application papers is required to apprise the inventor of the application to which the declaration is directed.

In addition, Petitioner provided a Federal Express tracking detail for delivery, which indicates that the package was delivered to Ms. Millikan's address on 06 April 2007. However, no signature for the delivery was obtained. Since Ms. Millikan did not sign for the papers delivered in 06 April 2007, it is not clear that Ms. Millikan actually received these papers. It may be that Ms. Millikan is no longer residing at the address provided. Petitioner must demonstrate with sufficient evidence that Ms. Millikan was presented with a complete copy of the application papers before it can be concluded that Ms. Millikan refuses to sign.

In sum, Petitioner has satisfied Items (1), (3) and (4) above. However, Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a *copy of the application papers for U.S. application 10/582,313 (specification, including claims, drawings, and declaration)* to the nonsigning inventor for her signature and (2) Ms. Millikan's refusal to sign, either in writing or by telephone, these documents.

For the reasons set forth above, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

The 15 June 2007 Notification of Acceptance is hereby **VACATED.**

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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